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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,084	03/26/2001	Michael E. Graves	12307/100173	2846

23838 7590 07/26/2005

KENYON & KENYON  
1500 K STREET NW  
SUITE 700  
WASHINGTON, DC 20005

EXAMINER
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WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,084

Applicant(s)

GRAVES ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-4-05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the amendment filed May 4, 2005.

### *Response to Arguments*

2. Applicant's arguments filed May 4, 2005 have been fully considered but they are not persuasive.
3. Applicants argue, "there is no motivation to combine Gifford and Bishop, as the problem solved by Bishop was already solved in Gifford".
4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Therefore, whether or not the problem was previously solved is not relevant. If, as asserted by Applicants, the problem was already solved, it only provides additional support that Applicants' limitations are old and well known in the art.
5. Applicants argue, "there is no suggestion that a component of the challenge message is to be displayed to the user and then digitally signed by the buyer"; however, the examiner disagrees. Notice, Bishop et al. teach receiving a challenge message and forwarding the challenge data to a **browser as signature request message**. Later, a smartcard suitably **signs**

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the block. It is known in the art that browsers are utilized to view documents; thus, the data of Bishop et al. is forward to the browser, which implies that the document will be displayed and later signed.

6. Applicants argue that Shwartz does not make up for the deficiencies of Gifford and Bishop. The examiner directs Applicants to the previous of action, which illustrates that Shwartz overcoming the deficiencies of Gifford and Bishop.

7. Claims 35-55 have been examined.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 35, 37-42, 44-49, 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6205437 to Gifford in view of U.S. Publication NO. 2004/0243520 to Bishop et al. and US Publication NO. 2001/0044787 to Shwartz et al.

Referring to claims 35 and 42, Gifford discloses storing a public key associated with a public key infrastructure (PKI) key pair in a profile database (see col. 10, lines 37-42), in response to receiving an authentication request from a buyer over a network, the authentication

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request including a description of the payment transaction and an identity of a seller (see col. 6, lines 16-32), storing a digitally signed record of the payment transaction in a transaction archive, i.e. "transaction database" (see col. 8, lines 16-19) and sending an authentication response to the seller over the network (see col. 6, lines 52-61). Gifford does not expressly disclose sending a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer and then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed summary of the payment transaction, determining whether the buyer has access to the private key by using the public key to decrypt the digitally signed message. Bishop et al. disclose sending a challenge request to the buyer over the network, the challenge request message to be displayed to the buyer then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed message, determining whether the buyer has access to the private key by using the public key to decrypt the digitally signed message (see paragraphs [0094] & [0095]). Shwartz et al. disclose the challenge request including a summary of the payment transaction (see paragraphs [0182]-[0184]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Gifford to include the steps of sending a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer and then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge

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response including the digitally signed summary of the payment transaction, determining whether the buyer has access to the private key by using the public key to decrypt the digitally signed message. One of ordinary skill in the art would have been motivated to do this because it protects the network server from attacks and improve the ease and safety of electronic commerce for consumers (see Bishop et al. & Schwartz et al.).

Referring to claims 37,44 and 51, Gifford discloses the method wherein the record of the payment transaction is digitally signed using the private key (see col. 10, lines 43-45).

Referring to claims 38,45 and 52, Gifford discloses the method wherein the record of the online transaction is digitally signed using a local private key (see col. 10, lines 48 & 49).

Referring to claims 39,46 and 53, Gifford discloses the method wherein the public key is stored in the form of a digital certificate representing that the public key is tied to the buyer (see col. 7, lines 44-46).

Referring to claims 40,47 and 54, Gifford discloses several databases including account database storing account information and an address database storing shipping address information (see col. 8, lines 12-24 and 33-36). Gifford also discloses receiving a selection of one of the plurality of payment instruments (i.e. "means of payment") and one of the plurality of shipping addresses from the buyer over the network (see col. 5, lines 34-50; col. 8, lines 33-35). Gifford does not expressly disclose retrieving a buyer profile from the database, the buyer profile including a plurality of payment instruments and a plurality of shipping address and sending the buyer profile to the buyer over the network; however, these are inherent steps. Before selecting the method of payment and address information, the buyer must first be provided with his profile.

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Referring to claims 41, 48 and 55, Gifford discloses processing the payment transaction via a payment gateway (i.e. "payment computer") see col. 6, lines 12-14.

Referring to claim 49, Gifford discloses a profile database, i.e. account database and address database, transaction archive, i.e. settlement database" (see col. 7, lines 66-67 & col. 8, lines 1-7) an authentication service web server (i.e. "payment computer") coupled to the profile database, the transaction archive and the network, the authentication service web server adaptively configured to (see col. 4, lines 46-55) store a public key associated with a public key infrastructure (PKI) key pair in a profile database (see col. 10, lines 37-42), in response to receiving an authentication request from a buyer over a network, the authentication request including a description of the payment transaction and an identity of a seller (see col. 6, lines 16-32), store a digitally signed record of the payment transaction in a transaction archive, i.e. "transaction database" (see col. 8, lines 16-19) and send an authentication response to the seller over the network (see col. 6, lines 52-61). Gifford does not expressly disclose the web server adaptively configured to send a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer then digitally signed by the buyer using a private key associated with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed summary of the payment transaction, determine whether the buyer has access to the private key by using the public key to decrypt the digitally signed summary of the payment transaction. Bishop et al. disclose sending a challenge request to the buyer over the network, the challenge request message to be displayed to the buyer then digitally signed by the buyer using a private key associated with the PKI key pair, or in response to receiving a challenge

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response from the buyer over the network, the challenge response including the digitally signed message, determining whether the buyer has access to the private key by using the public key to decrypt the digitally signed message (see paragraphs [0094] & [0095]). Shwartz et al. disclose the challenge request including a summary of the payment transaction (see paragraphs [0182]-[0184]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Gifford to include the steps of the web server adaptively configured to send a challenge request to the buyer over the network, the challenge request including a summary of the payment transaction to be displayed to the buyer then digitally signed by the buyer using a private key associate with the PKI key pair, or in response to receiving a challenge response from the buyer over the network, the challenge response including the digitally signed summary of the payment transaction, determine whether the buyer has access to the private key by using the public key to decrypt the digitally signed summary of the payment transaction. One of ordinary skill in the art would have been motivated to do this because it protects the network server from attacks and improve the ease and safety of electronic commerce for consumers (see Bishop et al. & Shwartz et al.).

10. Claims 36,43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, Bishop et al. and Shwartz et al. as applied to claims 35, 42 and 49 above, and further in view of US Publication NO. 2001/0014158 to Baltzley.

Gifford discloses PKI key pair (see claims 35 and 42 above). Gifford does not expressly disclose creating the PKI key pair, and sending the private key to the buyer over the network. Baltzley discloses creating the PKI key pair (see paragraph [0010], and sending the private key



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to the buyer over the network (see paragraph [0011]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Gifford to include the steps of creating the PKI key pair, and sending the private key to the buyer over the network. One of ordinary skill in the art would have been motivated to do this because it prevents fraud by providing additional security.

### *Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and (571)273-6714 for Non-Official/Draft.

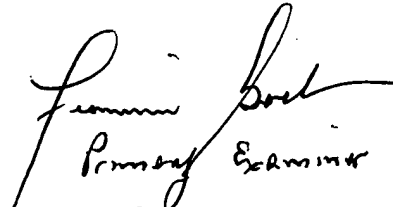
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Any response to this action should be mailed to:  
***Commissioner of Patents and Trademarks***  
***P.O. Box 1450***  
***Alexandria, VA 22313-1450***

  
Jalatee Worjloh  
Patent Examiner  
Art Unit 3621

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July 19, 2005

  
Primary Examiner  
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